

BERNHARD MUSSIG  
USSN 09/156,886

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--39. The method according to claim 38, which comprises applying the self-adhesive protective film to a painted surface of said vehicle before said vehicle is assembled.--

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CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicant respectfully requests that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicant respectfully requests reconsideration and allowance of this application in view of the amendments above and the following comments.

At the outset, Applicant points out that there were 19 original claims, although the Office Action only treats 18. Claim 19 appears at the very top of page 21 of the application.

Also, the original claims have been replaced by a new set of claims. The new claims are based on the original claims, but are slightly reworded to a form which is more near to the form conventionally applied in U.S. practice. For the Examiner's information, the new claims correspond to the original claims as follows:

<u>New Claim:</u>	<u>Based on Original Claim:</u>
20-32	1-13, respectively
33	15
34	14
35, 36	16, 17, respectively
37	New and based on disclosure in first paragraph of the specification
38, 39	18, 19, respectively

No new matter has been added.

Claims 1, 2, 4-6, 9-11, 16 and 17 were rejected under 35 USC § 102(b) as being anticipated by or, in the alternative, under 35 USC § 103(a) as being obvious over Babu et al. ("Babu"), U.S. Patent No. 5,209,971. In response, Applicant would remind the Examiner that anticipation requires that each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference, and, further, if the Examiner

relies on a theory of inherency as to any particular element, then the extrinsic evidence must make clear that such element is *necessarily* present in the thing described in the reference, and the presence of such element therein would be so recognized by persons skilled in the art. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Further, inherency is not established by probabilities or possibilities, and the mere fact that a property may result from a given circumstances is not sufficient; instead it must be shown that such property necessarily inheres in the thing described in the reference. *Id.* In the present case, the original claims required, and the new claims require, that the adhesive composition of the instant self-adhesive protective films comprises a copolymer “having a Mooney viscosity ML (1+4) 125°C of less than 50.” The Examiner has not pointed out where in Babu there is any express or inherent teaching of this particular property, nor has the Examiner explained why, if there is no express or inherent teaching of this property in Babu, then persons skilled in the art would have been motivated to use a copolymer having this property. In the absence of such further explanations, Applicant submits that the Examiner has not made out a *prima facie* case of either anticipation or obviousness. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

For completeness, Applicant points out that Babu also does not teach the method of claims 37-39.

Claims 3, 7, 8 and 12-15 were rejected under 35 USC § 103(a) as being obvious over Babu in view of Dobashi et al. ("Dobashi"), U.S. Patent No. 5,643,676. In response, Applicant points out that this rejection was premised upon Babu teaching the basic elements of Applicant's self-adhesive protective films. However, Applicant has explained above why Babu is inadequate in this regard. Dobashi does not bridge the clear gap between Babu's teachings and the instant claims. Accordingly, Applicant submits that the Examiner should reconsider and withdraw this rejection as well.

Claim 18 was rejected under 35 USC § 101 as being an improper process claim. In response, Applicant points out that claim 18, and, also, claim 19, have been recast as proper method claims 37-39.

Applicant believes that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicant also believes that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (914) 332-1700 so that the issue(s) might be promptly resolved.



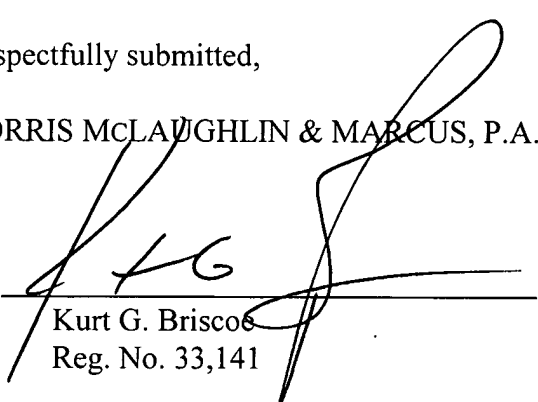
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Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By

  
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CERTIFICATE OF MAILING

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231, on the date indicated below:

Date: July 31, 2000

By

  
Kurt G. Briscoe